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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,287	08/23/2001	William L. Honnef	53588-0510	4132
29989 7590 02/21/2007 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110			EXAMINER LE, KHANH H	
			ART UNIT 3622	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/914,287

Applicant(s)

HONNEF ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 13, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 14, 25, 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-24, 26-28, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 5-6 is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the correspondence filed November 13, 2006. Claims 1-31 are pending, claims 1, 20, 21, 22, 23, 24, 25, 26, 27, 28-31 are independent. Claims 14, 25 and 29 are withdrawn. Claims 1-12, 13, 15-24, 26-28, and 30-31 (Group I) are elected and herein examined.

Response to Arguments as to Restriction:

2. Applicants elected Group 1A consisting of claims 1- 12, 13, 15-24, 26-28, and 30-31 for examination. (Applicants do not traverse restriction of Group II, and III).

However Applicants traverse the restriction as to claim 14 (Group IB). The traversal is acknowledged and fully considered, however, the restriction requirement is maintained.

First, contrary to argument, the examiner asserts a serious burden as different searches are required for original claim 13 (redemption at a telephone call center) and claim 14 (redemption at a physical store).

Second, Applicants argue original claims 13 and 14 were not mutually exclusive. However they are on their faces.

Original Claim 13: *A method as recited in Claim 1, further comprising the step of **receiving, at a telephone call center, information requesting redemption of the electronic stored value certificate as tender of all or a portion of payment for one or more goods or services***

Original Claim 14:

*A method as recited in Claim 1, further comprising the step of **receiving, at a physical store, information requesting redemption of the electronic stored value certificate as tender of all or a portion of payment for one or more goods or services.***

Applicants argue at page 18:

*"In the approach of the claims, an electronic certificate **could be redeemed in part via a call center and in part at a retail store.** Nothing in the claims says that the entire certificate value must be redeemed only in one location, and the Office Action cites nothing from the specification to infer such a limitation. Therefore, the species restriction is unsupported in fact.*

However, the original claims do not claim the combination as argued. Further, Applicants do not cite where in the specifications (and the Examiner cannot find where) it is disclosed the relationship as argued, i.e. that "an electronic certificate could be redeemed in part via a call center and in part at a retail store". Lastly, the rule for claim interpretation during

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examination is the broadest reasonable interpretation consistent with the specifications thus interpreting that the entire certificate value is redeemed in one location is reasonable since it's not inconsistent with the instant specifications.

Third, at page 17, Applicants challenge that MPEP 806.04(f) is of weak legal basis to rely on and that 37 CFR 1.141 expressly allows multiple species in an application when a generic claim is present. That is true, **but only for a generic claim that has been allowed.** The last Office Action stated:

"6c. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a)."

No claim is presently allowed.

Thus, for all the reasons above, the restriction requirement is proper.

Objections to Specifications

3. The brief descriptions of Figures 3D and 4C are inaccurate (the description of Fig. 3D should be for Fig. 3E). There are no brief descriptions of figures 3 and 3E. Appropriate corrections are required.

4. Duplicate claims

Applicant is advised that should claims 20 and 22 be found allowable, claims 5 and 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 5-6 only differ from independent claims 20 and 22, respectively, in the preambles, (a method of processing in claims 5-6, instead of a method of redeeming in claims 20 and 22. All the details in the preambles of claims 20 and 22 are inherently derived from the steps which are the same ones in claims 5-6. Therefore the 2 sets of claims are essentially duplicates.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. **Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 28 seems contradictory because first it is claimed that the merchant is the issuer ("by the merchant, issuing and activating..") then it seems there is a third party issuer who is communication with the merchant for certificate redemption ("...by communication of the merchant with the certificate issuer.."). Correction or clarification is required. For prior art application, it is interpreted the merchant is the issuer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

8. **Claims 1, 2, 4, 7-8, 10, 20, 23, 24, 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Dusen, US 6,175,823 B1, hereinafter, Van Dusen.**

VAN DUSEN discloses (independent claims 1, 23, 24, 26 27, 28):

a method of processing an electronic stored value certificate (abstract, Figures1, 2 and 5 and associated text) , comprising the steps of:

receiving a request to create an electronic stored value certificate and storing certificate information that identifies a recipient of the certificate, a recipient address, and an amount of the electronic stored value certificate (abstract; Figure 5 items 1,2, 4 and associated text; col. 3 lines 35-47);

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issuing and activating the electronic stored value certificate (Figures 2 and 5 and associated text; col. 3 line 61: sending the email to the recipient is taken as “activating” the gift certificate)

in response to successfully carrying out a purchase transaction that transfers value from an account associated with a purchaser of the electronic stored value certificate to a certificate issuer (Figure 2 and associated text; col. 3 lines 55-63: purchaser pays by credit card),

wherein the electronic stored value certificate may be redeemed for goods and services at one or more merchants (Figure 2 item 30; Figure 6 and associated text);

creating and storing a unique identification value for the electronic stored value certificate in association with the certificate information (Figure 2 item 30; Figure 6 and associated text) as part of activating the electronic stored value certificate;

wherein the unique identification value (Figure 5 item 90 and associated text) is a random value (col. 6 lines 20-22) that is non-negotiable in a commercial credit card network (VAN DUSEN’s unique claim code is not used in a commercial credit card network);

wherein the unique identification value is operable for redemption of the electronic stored value certificate at the merchant in a redemption transaction that does not traverse the commercial credit card network (Figure 2 item 30; Figure 6 and associated text) by communication of the merchant with the certificate issuer (*in VAN DUSEN, the merchant is also the certificate issuer and is in communication with itself among its different systems, such as memory/database 80 of Figure 4 where the generated certificates are stored and memory/database 78 of Figure 4 where gift accounts and their balances after redemption are stored*).

VAN DUSEN discloses (independent claim 20)

determining, from the database, a current value of the electronic stored value certificate associated with the unique identification value (Figure 6 items 110, 114 and associated text);

reducing the account containing the current value of the electronic stored value certificate (which reads on “the current value of the electronic stored value certificate”) by the amount of the order (abstract; col. 1 lines 64-67) ;

generating and returning an amount redeemed to a merchant (inherently the amount redeemed is generated and stored --i.e. “returned to the merchant”-- to keep track of the customer’s account balance).

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VAN DUSEN teaches (claim 7) (see Figure 5) : the “updated recipient identifying information” received from the certificate issuer is interpreted as the information as to whether recipient has an account with the issuer/merchant or not (Fig. 5 item 98) which is received by the system and based on which the “certificate information” (interpreted as the information needed to create the email to the recipient about the certificate) is updated (see Fig. 5 items 101 or 100).

Claims 2, 4, 8, and 10 are also taught at the citations given above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 3, 5-6, 9, 11-13, 15-19, 21-22, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dusen, in view of Official Notices.**

VAN DUSEN does not disclose (independent claims 21- 22) “*applying the electronic stored value certificate to the order by reducing the current value of the electronic stored value certificate to zero and attempting to receive the balance due for the order by carrying out a charge transaction that transfers value from an account associated with the recipient of the electronic stored value certificate to a certificate issuer with which the electronic stored value certificate may be redeemed; restoring the electronic stored value certificate to its previously determined current value in response to failure of the charge transaction.*”

However, Official Notice is taken that it is customary, if an purchase is made by a customer using two payment methods, such using part cash and part credit card, the merchant would accept the cash and attempt to collect payment for the balance of the purchase price via the second method of tender, i.e. the credit card , and if the credit card payment fails, the purchase would be void and the cash returned to the customer. Because it is obvious to follow common practices, it would have been obvious to one skilled in the art at the time the invention was made to add such practices to VAN DUSEN, with the certificate used in lieu of and treated as the cash in the above example and thereby arrive at the above claimed limitation.

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VAN DUSEN does not disclose (independent claims 30 and 31) a third party issuer or reseller of the gift certificate.

However, Official Notice is taken that it is well-known to contract out tasks that one does not desire to perform oneself to a third party, for example because the third party performs the task more efficiently or at better costs. Thus it would have been obvious to one skilled in the art at the time the invention was made to add to VAN DUSEN a third party to issue the certificate for redemption at the merchant for the above stated advantage of cost and performance efficiency.

Further claims 30 and 31 are method claims and having a third party issue and or resell the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the third party or not. Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: “[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.” Here, the third party merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the third party issuer limitation is not given patentable weight.

Further, even in structure claims, it has been held that making parts separable would be obvious “if it were considered desirable for any reason”. See In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (“The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is “press fitted” and therefore not manually removable. The court held that “if it were considered desirable for any reason to obtain access to the end of [the prior art’s] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.”). Here as stated above, the reason might be that the third party performs the task more efficiently or at better costs.

VAN DUSEN does not disclose (claim 3) the gift-giver profile is taken from prior sales data but does disclose the recipient profile is taken from prior sales data to expedite processing (col. 3 lines 65-67; col. 5 lines 54-64: user ID’s, credit card numbers; Figure 5 item 100 and associated text)). Because both the gift-giver and the gift recipients are customers of the system, it would have been obvious to one skilled in the art at the time the invention was made to apply the same profiling techniques to the gift-giver to expedite processing (VAN DUSEN, col. 5 lines 54-64).

VAN DUSEN teaches (claim 11) keeping track of the gift account which contains the certificate value (see at least abstract, citations above), and inherently discloses zeroing the account if the purchase amount exceeds the certificate value, where the account only contains

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certificate value (which reads on “if so depleting the certificate value to zero”): VAN DUSEN also inherently discloses returning (paying) the amount redeemed to the merchant.

VAN DUSEN discloses (Claim 12) selling a “merchant-branded certificate” (amazon.com) to gift giver. Claims 5-6, and 9 are also taught at the citations given above.

VAN DUSEN does not disclose (claim 13) a call center for redemption. However Official Notice is taken that it is old and well-known to use call centers to provide redemption service to customers who prefer that method. Thus it would have been obvious to one skilled in the art at the time the invention was made to add a call center to VAN DUSEN’s redemption scheme for the above stated advantage.

VAN DUSEN does not disclose (Claims 15) a condition to redeem a minimum purchase amount ; (claim 16) recipient needs be first time customer ; (claim 17) a condition to buy specified goods and services.

However, Official Notice is taken that it is old and well-known for companies to provide employee rewards or for merchants to provide loyalty values in the form of reward certificates. It would have been obvious to one skilled in the art at the time the invention was made to use the VAN DUSEN system as a vehicle to effect providing such loyalty or reward values. It is also well-known to impose conditions, such as the claimed limitations above, usually for co-branding purposes or to promote sales of a sponsoring merchant. Thus it would have been obvious to one skilled in the art at the time the invention was made to impose the above claimed conditions to the VAN DUSEN system to achieve the above co-branding, or sales promotions goals.

VAN DUSEN does not disclose (claims 18, 19) taxes, shipping or handling charges added to the purchase total , and “determining whether applying the current value of the electronic stored value certificate to the amount of the order results in a balance due for the order, and if so, generating information that prompts the recipient to add value to the certificate.”

However, Official Notice is taken that taxes are often added to a purchase price and also it is customary to include shipping and handling charges. Further it is customary to tender additional payment if one source of payment is not sufficient. For example, one may tender both cash and credit card payment for a purchase.

Because it is obvious to follow common practices for the above stated goals or advantages, it would have been obvious to one skilled in the art at the time the invention was made to add such practices to VAN DUSEN, with the certificate used in lieu of and treated as the cash in the above example and thereby arrive at the above claimed limitation.

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Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Pair of Web Companies Launch Gift Certificates Products for Holidays"
"Electronic Advertising and Marketplace Report, v12, n22,pNA, Dec 1,1998, discloses the gift certificates system of

...Webcertificate.com whereby the buyers customize the certificates using a template, indicate how

much they want to spend, enter name and email address of the recipient and add an optional personalized email address. They then pay by credit card.

Once the recipient receives the notification e-mail they follow the email instructions to activate the certificate including a link to a personal gift page at the Webcertificate site. Once at the

website, they enter a personal claim code and are presented with the Webcertificate.

The system assigns users a Webcertificate account number and expiration date. Users can then offer

the account number in place of a credit card at any online merchant on the Web, although they are

prompted to use a list of suggested sites. When purchases are made the amount is automatically deducted from the gift account. Users can check their remaining balances through the Webcertificate site.

Williams et al, US 5815657 A, discloses e-purse system including coupons, certificates (Fig. 29-30) used together with credit cards etc...

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

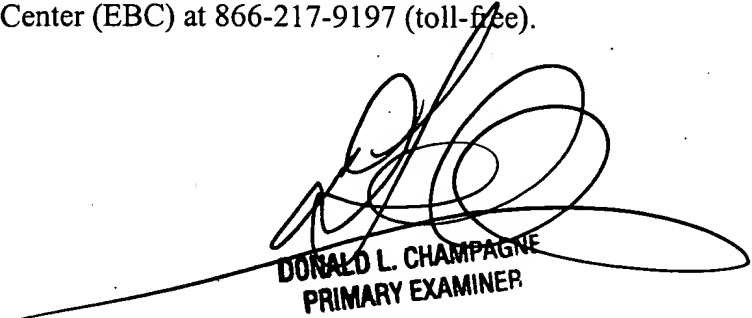
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February 1, 2007

KHL

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DONALD L. CHAMPAGNE
PRIMARY EXAMINER